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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/537,609	06/03/2005	Norihiko Nakahara	07409.0043	4952
22852 7590 04/23/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER HUNTER, ALVIN A	
			ART UNIT 3711	PAPER NUMBER
			MAIL DATE 04/23/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/537,609	Applicant(s) NAKAHARA ET AL.	
	Examiner ALVIN A. HUNTER	Art Unit 3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/04/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 8 recites that the projecting portion projecting from the inner surface by 3mm or more. This language is indefinite because the projecting portion can project such that it touches the opposite surface which would prevent the bladder to forming the club head.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacKay, Jr. et al. (USPN 5904628) in view of Satoh (USPN 6287214).

Regarding claim 7, MacKay, Jr. discloses a club head comprising an outer shell member, a hollow portion surrounded by the outer shell member, and a columnar neck member wherein the inner surface of the hollow portion includes a concave surface having no projecting portion formed thereon. MacKay, Jr. does not disclose the

Art Unit: 3711

columnar neck having an insertion hole for that shaft that is closed at a hollow portion side. Satoh discloses that it is conventional to construct a columnar neck being closed at the hollow portion (See Figure 6 and Background of the invention). One having ordinary skill in the art would have found it obvious to have the insertion hole of the columnar neck closed at the hollow portion, as taught by Satoh, because it is common within the art.

Regarding claim 9, MacKay, Jr. discloses a club head comprising an outer shell member, a hollow portion surrounded by the outer shell member, and a columnar neck member wherein the inner surface of the hollow portion includes a concave surface having no projecting portion formed thereon. MacKay, Jr. does not disclose the columnar neck having an insertion hole for that shaft that is closed at a hollow portion side. Satoh discloses that it is conventional to construct a columnar neck being closed at the hollow portion (See Figure 6 and Background of the invention). One having ordinary skill in the art would have found it obvious to have the insertion hole of the columnar neck closed at the hollow portion, as taught by Satoh, because it is common within the art. MacKay notes that a shaft having a grip is attached to the club head.

Regarding claims 10 and 11, the limitations are directed to a product by process. Because the final product is the same, it is submitted that MacKay, Jr. et al. meets these limitations.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nagamoto (USPN 5669827) in view of OFFICIAL NOTICE.

Regarding claim 8, Nagamoto discloses a golf club head having an outer shell member and a hollow portion surrounded by the outer shell member wherein an inner surface of the hollow portion includes a flat portion and a projecting portion (See Figure 2). Applicant does not note the importance of the shape or the radius of the projecting portion to the nature of the invention; therefore, one having ordinary skill in the art would conclude that the shape and radius of the projecting portion are design parameters. The projecting portion of Nagamoto would perform equally as well being that it lowers the weight of the club head. Nagamoto does not show a shaft having a grip. OFFICIAL NOTICE is taken that having a shaft with a grip attached to a club head is commonly known in order to facilitate swinging it. One having ordinary skill in the art would have found it obvious to have a shaft with a grip attached to the club head of Nagamoto because it is common known to do such with club heads.

Response to Arguments

Applicant's arguments with respect to claims 7-11 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed with respect to claim 8 on 2/04/08 have been fully considered but they are not persuasive. The applicant argues that the importance of the shape and curvature of the projecting portion is such that it utilizes a bladder to form the hollow portion so that it is necessary to define the shape and radius of the projecting portion to protect the bladder. The bladder is not a part of the club head. Further, the bladder conforms to the shape of the mold or inner surface of the club head. Regardless of the radius, the bladder would conform to the shape.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN A. HUNTER whose telephone number is (571)272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

Art Unit: 3711

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/A. A. H./

Examiner, Art Unit 3711

/Gene Kim/

Supervisory Patent Examiner, Art Unit 3711